



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,073	12/12/2000	Shirin Asina	ROGO-214.2-Cont	3402
24972	7590	01/13/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			NAFF, DAVID M	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	
			1651	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/735,073

Applicant(s)

ASINA ET AL.

Examiner

David M. Naff

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: _____.

Claim(s) rejected: 115-122.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

David M. Naff
Primary Examiner
Art Unit: 1651

ATTACHMENT TO FORM PTOL-303

The amendment has not been entered since the amendment to claims 121 and 122 raises new issues for consideration under 35 U.S.C. 112, second paragraph. The claims are unclear as to whether the RENCA cells are the entrapped cancer cells or the cancer cells which are inhibited from proliferating. It is suggested the claims be amended to read as follows.

121. The culture medium of claim 119, wherein the entrapped cancer cells in the process are RENCA cells.

122. The frozen culture medium of claim 120, wherein the entrapped cancer cells in the process are RENCA cells.

The 35 U.S.C. 103 rejection of claims 115-122 is withdrawn.

The 112, first paragraph, rejection of claims 115, 117 and 119-122 is maintained. While there is no mention of 30 kd in the '497 patent as urged by applicants, the present application is a CIP of the '497 patent, and discloses that the cancer cell inhibiting material has a molecular weight of at least about 30 kd. The disclosures of both applications must be considered together and not only the '497 patent alone. The reason there is no disclosure of the molecular weight in the '497 patent is because the molecular weight was not determined. The material in the '497 patent inherently has the molecular weight described in the instant application.

Art Unit: 1651

The obviousness double patenting rejection of claims 115-122 over the claims of patent 6,224,912 B1 is maintained. Applicants' assert that claims without a molecular weight of at least 30 kd should not be subject to the rejection. However, these claims do not exclude the molecular weight that is required by the claims of the patent, and the cancer cell inhibiting material of the instant claims can have the same molecular weight as required by the patent claims.

Obviousness double patenting rejection of claims 115, 117 and 119-122 is maintained over the claims of the '497 patent alone without Jain et al (WO). It would have been obvious from the patent claims that the material that suppresses cancer cell proliferation will diffuse into a culture medium due to the material diffusing out of the bead. Collecting or recovering the medium would have been obvious to obtain the material that diffuses into the medium from the bead. Freezing the medium would have been obvious to preserve the medium during storage.

Claims 115, 117 and 119-122 would be free of the 112, first paragraph, rejection, and the obvious double patent rejection over the claims of the '497 patent if claims 115 and 117 are amended to require the molecular weight of claims 116 and 118 respectively.

Art Unit: 1651

Claims 121 and 122 would be free of being rejectable under 112, second paragraph, if amended as set forth above.

The claims would be free of the obvious double patenting rejection over the claims of the '912 patent if a terminal disclaimer is submitted.

Amended claims should be submitted in a separately filed amendment along with an appropriate request for an extension of time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is 703-308-0520. The examiner can normally be reached on Monday-Friday 9:30-6:00.

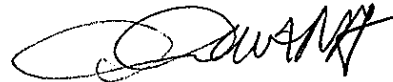
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 09/735,073

Page 5

Art Unit: 1651

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

A handwritten signature in black ink, appearing to read "D. Naff", with a large, stylized loop at the beginning.

David M. Naff
Primary Examiner
Art Unit 1651

DMN

1/8/04